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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,277	11/27/2001	David B. Donahue	10547-0018-999	2377

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THE DIRECTV GROUP INC
PATENT DOCKET ADMINISTRATION RE/R11/A109
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EXAMINER

ENG, DAVID Y

ART UNIT PAPER NUMBER

2155

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/996,277

Applicant(s)

DONAHUE ET AL.

Examiner

DAVID Y. ENG

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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The active claims are 1-18.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Shapiro (USP 5,991,810).

See at least the abstract, Figure 1 and the description thereof in Shapiro. Shapiro teaches a gateway 22 comprising a CPU 24, a communication circuit (bus 30 and the control thereof) and a memory 26. As to the content of the memory, the court held that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959. “[Apparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647. See MPEP 2114.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babbitt (USP 6,618,757).

With respect to all independent claims 1, 8 and 18, and dependent claims 3-5, see at least the abstract, Figures 1 and 2 and the description thereof in Babbitt. Babbitt teaches a system for providing a publicly routable Internet Protocol address to a host computer located on a private network. The system includes a gateway 16 connected between a private network and a public network (Internet), a DHCP and a NAT connected to the gateway (See Figures 1 and 2 and the abstract in Babbitt), and a host (see "subscriber" in Babbitt, column 1 line 49 and column 3 line 16, etc. for examples). Babbitt also teaches assigning public IP addresses and private IP addresses to entities connected to the networks (see "assign.." throughout the specification of Babbitt, for examples, see "assigning" in line 8 of the abstract, lines 29, 39, 42 and 49 of column 1, etc.). Babbitt does not specify which particular entities are assigned with public or private IP addresses. It is well known in the art that IP addresses must be assigned to any network including any private or public networks in order for the entities couple thereto to communication with each other (column 1, lines 38-44). It is also well known that public IP addresses must be used for communication if public network is used for communication by the entities, vise versa for private network. It would have been obvious to a person of ordinary skill in the art to assign private and public IP address to entities coupled to the private or public networks such that they are able to communicate with each other.

As to claim 2, see ISP in line 8 of column 8.

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As to claim 6, see web page in line 18 of column 10 in Babbitt.

As to claim 7, see NAT in Figures 1 and 2.

A handwritten signature in black ink, appearing to read 'D. Eng', with a long, sweeping horizontal stroke extending to the right.

DAVID Y. ENG
PRIMARY EXAMINER